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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,762	06/01/2001	Sean M. McCullough	VIGN 1230-1	7625
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SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			EXAMINER STORK, KYLE R	
			ART UNIT 2178	PAPER NUMBER
DATE MAILED: 10/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,762

Applicant(s)

MCCULLOUGH, SEAN M.

Examiner

Kyle R. Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to the request for continued examination and amendments filed 25 July 2005.
2. Claims 1-23 are pending. Claims 1, 12, and 23 are independent claims. The rejection of claims 1-22 under 35 U.S.C. 102 and 35 U.S.C. 103 have been withdrawn as necessitated by the amendment.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 20 September 2004, 28 February 2005, and 04 April 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have being considered by the examiner.

Claim Rejections - 35 USC § 112

4. Claims 5-7 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per dependent claims 5 and 16, which depend upon claims 1 and 12 respectively, the applicant recites the limitation, "wherein the rendered element is displayed instead of the target element (lines 1-2)." However, the amended limitations of claims 1 and 12 require, "displaying the rendered element in conjunction with the

Art Unit: 2178

target element (line 7)." It is unclear to the examiner how the rendered element can be concurrently be displayed in conjunction with and instead of a target element.

Claims 6-7 and 17-18 are subsequently rejected based upon their dependence upon a rejected base claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 8-15, and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lerner et al. (US 6859909, filed 7 March 2000, hereafter Lerner).

As per independent claim 1, Lerner discloses a method of modifying a target document comprising:

- Accessing a target document, a metadata element, and a rendering instruction, wherein the target document comprises a target element (column 5, lines 9-32 and Figure 5: Here, a pointer to an original web based document (WBD) is stored in order to access a target document, which comprises a target element.

Further, a metadata element, in this instance, an annotation, is stored in an

annotation record. Further, the rendering instruction for the metadata elements are stored in an image file containing the appearances of the metadata)

- Locating the target element to which the metadata element applies (Figure 5; column 5, lines 9-32: Here, the annotation record maintains a pointer to the target element that an annotation modifies)
- Transforming the metadata element into a rendered element by using the rendering instruction (Figure 5; column 5, lines 9-32)
- Displaying the rendered element in conjunction with the target element (Figures 8, 10, 15-16, and 18-19: Here, rendered metadata elements (annotations) are displayed in conjunction with the target elements (WBDs))

As per dependent claim 2, Lerner discloses the method further comprising calculating screen coordinates relative to the target document where the rendered element is to be displayed (column 6, line 64- column 8, line 20; column 8, lines 13-36: Here, the user is allowed to ink annotations over a document. This in turn causes the document to become frozen to prevent reflowing of the target elements (WBD). However, the annotation maintains the position of the inking relative to the target document).

As per dependent claim 3, Lerner discloses the method further comprising displaying the rendered element in conjunction with the target element at the screen coordinates (Figures 8, 10, 15-16, and 18-19; column 6, line 64- column 8, line 20).

As per dependent claim 4, Lerner discloses the method wherein locating further comprises matching a term within the metadata element with a corresponding term within the rendering instruction (column 9, line 58-column 10, line 36).

As per dependent claim 8, Lerner discloses the method further comprising inserting the rendered element into the target document (Figures 8, 10, 15-16, and 18-19).

As per dependent claim 9, Lerner discloses the method wherein, when after inserting, the rendered element overlays the target element and the target element can be seen at least partially through the rendered element (Figures 8, 10, 15-16, and 18-19).

As per dependent claim 10, Lerner discloses the method wherein a tag within the metadata element includes a locating information to locate the target element within the target document (column 6, line 64- column 8, line 20; column 8, lines 13-36; column 9, line 58-column 10, line 36).

As per dependent claim 11, Lerner discloses the method wherein the metadata element includes an identifier for the target document (Figure 5).

As per independent claim 12, the applicant discloses the limitations similar to those in claim 1. Claim 12 is similarly rejected.

As per dependent claim 13, the applicant discloses the limitations similar to those in claim 2. Claim 13 is similarly rejected.

As per dependent claim 14, the applicant discloses the limitations similar to those in claim 3. Claim 14 is similarly rejected.

As per dependent claim 15, the applicant discloses the limitations similar to those in claim 4. Claim 15 is similarly rejected.

As per dependent claim 19, the applicant discloses the limitations similar to those in claim 8. Claim 19 is similarly rejected.

As per dependent claim 20, the applicant discloses the limitations similar to those in claim 9. Claim 20 is similarly rejected.

As per dependent claim 21, the applicant discloses the limitations similar to those in claim 10. Claim 21 is similarly rejected.

As per dependent claim 22, the applicant discloses the limitations similar to those in claim 11. Claim 22 is similarly rejected.

As per independent claim 23, the applicant discloses the limitations similar to those in claim 1. Claim 23 is similarly rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner.

As per dependent claim 5, Lerner discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Lerner further discloses the

method wherein the rendered element is displayed instead of a target element (Figure 14 and 15A: Here, an annotation is inserted into the browser over the WBD. If the WBD is no longer displayed, then the flowchart ends).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner's method of displaying elements with Lerner's method of displaying the rendered element instead of the target elements, since it would have allowed a user to create notes in a blank document.

As per dependent claim 6, Lerner discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lerner further discloses the method wherein the rendered element includes a row or column of icons (Figure 8, item 820 and 825: Here, the rendered annotation element contains a row of icons).

As per dependent claim 7, Lerner discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lerner further discloses the method wherein:

- The target element includes numerical information (Figure 5, item 530; column 5, lines 19-21: Here, a target element contains a time/date stamp that specifies a time/date an annotation was created for the WBD)
- The rendered element includes a depiction of the numerical information (Figure 16: Here, a date is listed along the bottom of each annotated WBD)
- The depiction includes a representation of the numerical information in at least two dimensions (Figure 16)

As per dependent claim 16, the applicant discloses the limitations similar to those in claim 5. Claim 16 is similarly rejected.

As per dependent claim 17, the applicant discloses the limitations similar to those in claim 6. Claim 17 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 7. Claim 18 is similarly rejected.

Response to Arguments

9. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

As disclosed above, the Lerner reference has been added to address the claimed limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

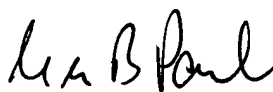
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178

krS


CESAR PAULA
PRIMARY EXAMINER